

## RESPONSE

### Status of the Claims

Claims 1-37 are pending in the application. Applicants hereby cancel without prejudice claims 22-37. Applicants hereby add new claims 38-60. After entry of this amendment, claims 1-21 and 38-60 will be pending in the present application. In accord with 35 U.S.C. § 1.121, attached is a clean copy of all pending claims. The new claims introduce no new matter.

Support for the new claims may be found throughout the originally filed specification, figures, and claims. For example, support for the new independent claims 38-60 may be found at least at page 29, lines 21-28, to page 30, lines 1-21, and in the claims originally filed claims.

The Office Action rejects claims 1-21 and 26-37 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,961,804 to Jacobson *et al.* (“Jacobson”). Applicants submit that the rejection of claims 26-37 is moot because these claims are cancelled without prejudice by the present amendment. Applicants ask the Examiner to reconsider the rejections in light of the following comments.

### Rejections under 35 U.S.C. § 103 (a)

Independent claim 1, and the claims that depend therefrom, were rejected under §103 (a) as being unpatentable over Jacobson. The Office Action states that

Jacobson *et al.* discloses a single microcapsule (320) (see fig. 6) comprising a clear particle (620), a black particle (410) and a single colored particle (610), for producing a single colored subpixel (col. 12, lines 11-22). Jacobson *et al.* further teaches that in a full color RGB reflective display, a white color of a pixel is formed of individual colored states red, green and blue (col. 12, lines 7-11). (**Office Action, page 3**)

Applicants acknowledge that, as shown in Fig. 6A and as contained in (col. 12, lines 5-17), Jacobson teaches a display element having *a single microcapsule* 320. However, Applicants submit that Jacobson fails to teach or fairly suggest an electrophoretic display element comprising *a first capsule and a second capsule* as set forth in Applicants’ claim 1. Jacobson fails to teach or suggest multiple capsules because Jacobson relies on *one capsule* having multiple species of particles to provide a color display. (See, e.g., Jacobson Figures 4A, 4B, and col. 10, lines 10-16.) Jacobson’s teaching that one capsule will suffice does not fairly suggest the use of multiple capsules as set forth in Applicants’ claims. In contrast to Jacobson, Applicants’ claim 1 requires an electrophoretic display element comprising “*a first capsule...and...a second capsule.*” Thus, Jacobson fails to teach or fairly suggest all elements of Applicants claim 1. Applicants therefore

submit that claim 1, and claims 2-21 that depend therefrom, are patentable and not obvious over Jacobson.

Further, Applicants submit that Jacobson fails to render obvious claim 4 because Jacobson fails to teach or fairly suggest generating white in a color display element by using white particles. Claim 4 recites an electrophoretic display element, “wherein the first, third and seventh optical properties have a white visual appearance.”

The Office Action states that

the selection of the particular colors of the microparticles and suspending fluid would have been an obvious matter of design choice, since such a modification would have involved a mere change in color which depends upon the characteristic of the display, e.g., in a black and white display, black and white particles may be employed and in a full-color RGB display, green, blue, and red particles may be employed. (**Office Action, pages 4-5**)

Applicants respectfully disagree with the Office Action’s characterization of Jacobson. Jacobson teaches in relevant part,

*a full-color reflective display, the individual colored states red, green, and blue desirably have reflectivities corresponding to at least three times the normal reflectivity of printed red, green and blue, so that when added their sum is paper white.* (column 12, lines 7-12, emphasis added).

Thus, Applicants’ submit that Jacobson teaches that a white appearance is achieved, not by white particles within a capsule, but by combining red, green, and blue particles of appropriate reflectivities that sum to provide a “process white.” As a result, Jacobson does not teach or fairly suggest white particles as set forth in Applicants’ claims.

Further, the Office Action states that, with reference to Jacobson, the “selection of the particular colors of the microparticles and suspending fluid would have been an obvious matter of design choice, since such a modification would have involved a mere change in color.” Applicants must respectfully disagree. Modifying the full-color RGB display of Jacobson to comprise particles that “have a white visual appearance” would render Jacobson inoperable for its intended purpose. Substituting the individual red, green or blue particles with particles of any other color, including the claimed white particles, would render Jacobson unable to produce the “process white” as taught therein. In addition, substituting white particles for the red, green, or blue particles would make Jacobson inoperable as a full-color display. Thus, modifying the

colors of the full-color RGB display of Jacobson is improper because such a modification would render Jacobson inoperable for its intended purpose.

Regarding new claims, 38-60, Applicant provides the following remarks with respect to Jacobson. New independent claim 38 recites, in relevant part, "a *first capsule including* a first plurality of *white particles*...and...a *second capsule*." As set forth above, Applicants submit that Jacobson fails to teach or fairly suggest either multiple capsules or white particles in a color display. Accordingly, Applicants respectfully submit that Jacobson does not render new independent claim 38, and claims 39-60 that depend therefrom, obvious.

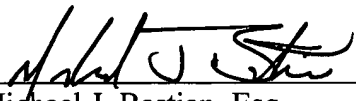
### CONCLUSION

Applicants request that the Examiner reconsider the application and claims in light of the foregoing Response, and respectfully submit that the claims are in condition for allowance. If, in the Examiner's opinion, a telephonic interview would serve to clarify issues and expedite the favorable prosecution of the present application, the undersigned attorney would welcome the opportunity to discuss any outstanding issues, and to work with the Examiner toward placing the application in condition for allowance.

Respectfully submitted,

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